

REMARKS

Claims 1-44 remain pending in the present application. Claim 29 is amended herein to fix a clerical claim numbering error. No new matter has been added.

Claim Rejections - 35 U.S.C. §102

The present office action states that Claims 1-5, 7-15 and 29-30 are rejected under 35 U.S.C. § 102(e) as being anticipated by Raley et al. (2002/0108050).

Applicants have reviewed the cited reference and respectfully submit that the embodiments of the present invention as recited in Claims 1-5, 7-15 and 29-30 are not anticipated by Raley et al. for the following reasons.

I. With respect to Claims 29 and 30, Applicants have amended Claim 29 herein to correct a clerical claim numbering error with respect to Claim 29 being dependent on Claim 16. As such, Applicants respectfully submit Claims 29 and 30 are dependent on independent Claim 16 which, according to the present Office Action, is not anticipated by Raley et al.

Therefore, Applicants respectfully submit the rejection of Claims 29 and 30 under 35 U.S.C. § 102(e) is moot.

II. With respect to Claims 1-5 and 7-15, as stated by the Federal Circuit of Appeals in *In re Oetiker*:

[T]he examiner cannot sit mum, leaving the applicant to shoot arrows in the dark hoping to somehow hit a secret objection harbored by the examiner. The "prima facie" case notion, the exact origin of which appears obscure..., seemingly was intended to leave no doubt among the examiners that they must state clearly and specifically any objections (the prima facie case) to patentability, and give the applicant fair opportunity to meet those objections with evidence and argument. To that extent the concept serves to level the playing field and reduces the likelihood of administrative arbitrariness. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1447 (Fed. Cir. 1992)

Applicants respectfully submit that the rejection of Claims 1-5 and 7-15 as provided in the present Office Action does not clearly and specifically provide any objections to patentability, thereby denying the Applicants fair opportunity to meet the objections with evidence and argument.

Instead, the Office Action appears to be a copy of the Applicants Claims with paragraph numbers inserted therein.

As such, Applicants respectfully submit that a prima facie case for anticipate under 35 U.S.C. § 102(e) has not been made and as such Claims 1-5 and 7-15 are in condition for allowance.

III. Applicants respectfully state that independent Claim 1 includes the feature “A method for selectively controlling access to media disposed on a media storage device, said method comprising:

installing a compliance mechanism on a computer system, said compliance mechanism communicatively coupled with said computer system when installed thereon, said compliance mechanism for enforcing compliance with a usage restriction applicable to said media;

obtaining control of a data pathway operable on said computer system;
accessing data disposed on said media storage device to determine said usage restriction; and

selectively preventing said computer system from digitally accessing said media via said data pathway while enabling presentation of the media.” (Emphasis added)

According to the Federal Circuit, “[a]nticipation requires the disclosure in a single prior art reference of each claim under consideration” (W.L. Gore & Assocs. v. Garlock Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Moreover, in order to establish anticipation under 35 U.S.C. § 102 the cited art must not only disclose all elements of the claim, but must also disclose those elements

“arranged as in the claim.” Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548 (Fed. Cir. 1983).

Applicants respectfully disagree that Raley et al. anticipates the claimed features and discloses all the elements arranged as in the Claims.

That is, Applicants have reviewed Raley et al. and do not understand Raley et al. to anticipate the features, “selectively preventing said computer system from digitally accessing said media via said data pathway while enabling presentation of the media.”

In contrast, Applicants respectfully submit that at least paragraphs [0055], [0057], [0105] and [0111] of Raley et al. are understood by Applicants to teach away from the claimed features. For example, [0055] is understood to teach that a web site cannot be accessed. [0057] is understood to teach access being prohibited. [0105] is understood to teach that directories are filtered in order to provide a high level of confidence that content stored on the distributor server as a file cannot be delivered to an unauthorized user no matter what URL is used to reach the file stored on the server. Similarly, [0111] is understood to teach that access to content will be denied.

As such, Applicants respectfully submit that since Raley et al. does not disclose all of the Claimed features, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate Claim 1 under 35 U.S.C. § 102(e).

With respect to Claims 2-5 and 7-15, Applicants respectfully point out that Claims 2-5 and 7-15 are allowable as depending from the allowable Independent Claim 1 and reciting further features thereof.

Claim Rejections - 35 U.S.C. §103(a)

Claims 16-28 and 31-44

The present office action states that Claims 16-28 and 31-44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Searle (WO 01/46952) in view of Raley et al.

I. According to MPEP 2141(III) (citing KSR Int'l vs. Teleflex, Inc., 127 S. Ct. 1727), “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (Emphasis Added)

Applicants respectfully submit that the Rejection has not satisfied a *prima facie* case of obviousness. Instead, the Office Action has relied upon speculation and less than a preponderance of evidence.

Specifically, the rationale argued in the present Office Action for combining Searle and Raley et al. is “in order to enhance the security of the system.” Applicants respectfully contend that the statement “in order to enhance the security of the system” is speculative, unsupported with a preponderance of evidence, and appear to Applicants to be based on improper hindsight.

Further, the Office Action has provided no evidence as to how information from Searle or Raley et al. would have made the invention obvious to a person of ordinary skill in the art. Instead, the Office Action has relied upon an indefinite relational term “enhance the security of the system” without providing any evidence as to how security is enhanced, what enhancement means, to whom the enhancement would be recognized, what is meant by security of the system, etc.

As such, Applicants respectfully submit that a *prima facie* case for obviousness under 35 U.S.C. § 103(a) has not been made and that the rejection of Claims 16-28 and 31-44 is improper and should be withdrawn.

As such, Applicants respectfully submit Claims 16-28 and 31-44 are in condition for allowance.

II. MPEP 2143.01 states “if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious” (*In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). (emphasis added)

Independent Claim 31 (and similarly Claim 16) includes the features, “selectively restricting said media on said media storage device from being accessed via said digital data pathway while enabling presentation of said media using an analog sound rendering device communicatively coupled with said device drive.” (Emphasis Added)

Applicants understand Raley et al. to teach directly away from the claimed features and respectfully submit that the proposed modification would change the principle of operation of Raley et al.

Specifically, Applicants respectfully submit that at least paragraphs [0055], [0057], [0105] and [0111] of Raley et al. are understood by Applicants to teach away from the claimed features and toward the principle of operation of Raley et al. e.g., denial of access. For example, [0055] is understood to teach that a web site cannot be accessed. [0057] is understood to teach access being prohibited. [0105] is understood to teach that directories are filtered in order to provide a high level of confidence that content stored on the distributor server as a file cannot be delivered to an unauthorized user no matter what URL is used to reach the file stored on the server. Similarly, [0111] is understood to teach that access to content will be denied.

For this reason, Applicants respectfully submit that a *prima facie* case for obviousness under 35 U.S.C. § 103(a) has not been made and that Claims 16 and 31 are in condition for allowance.

With respect to Claims 17-28 and 32-44, Applicants respectfully point out that Claims 17-28 are allowable as depending from the allowable Independent Claim 16 and

that Claims 32-44 are allowable as pending from the allowable independent Claim 31, and respectively reciting further features thereof.

Claim 6

The present office action states that Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Raley et al. in view of Searle.

I. According to MPEP 2141(III) (citing KSR Int'l vs. Teleflex, Inc., 127 S. Ct. 1727), "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (Emphasis Added)

Applicants respectfully submit that the Rejection has not satisfied a *prima facie* case of obviousness. Instead, the Office Action has relied upon speculation and less than a preponderance of evidence.

Specifically, the rationale argued in the present Office Action for combining Raley et al. and Searle is "in order to enhance usability of the system." Applicants respectfully contend that the statement "in order to enhance usability of the system" is speculative, unsupported with a preponderance of evidence, and appear to Applicants to be based on improper hindsight.

Further, the Office Action has provided no evidence as to how information from Searle or Raley et al. would have made the invention obvious to a person of ordinary skill in the art. Instead, the Office Action has relied upon an indefinite relational term "enhance usability of the system" without providing any evidence as to how usability is enhanced, what enhancement means, to whom the enhancement would be recognized, what is meant by usability of the system, etc.

As such, Applicants respectfully submit that a prima facie case for obviousness under 35 U.S.C. § 103(a) has not been made and that the rejection of Claim 6 is improper and should be withdrawn.

As such, Applicants respectfully submit Claim 6 is in condition for allowance.

CONCLUSION

Based on the arguments presented above, Applicants respectfully assert that Claims 1-44 overcome the rejections of record, and therefore, Applicants respectfully solicit allowance of these Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,
Wagner Blecher LLP

Date: March 10, 2010

/John P. Wagner, Jr./

John P. Wagner, Jr.
Reg. No. 35,398

WESTRIDGE BUSINESS PARK
123 WESTRIDGE DRIVE
WATSONVILLE, CALIFORNIA 95076
(408) 377-0500